

Appl. No. 10/755,427

Amendment dated September 11, 2008

Reply to Office Action Mailed June 13, 2008

REMARKS

The above-identified application has been reviewed in light of the Final Office Action mailed on June 13, 2008. By the present amendment, claims 1 and 19 have been amended herein. It is respectfully submitted that the pending claims are fully supported by the specification, introduce no new matter, and are allowable over the references of record.

The applicants would like to the Examiner Diane Yabut for the courtesy extended to the applicants' representatives, Dana A. Brussel and Roberto Colón, during the interview conducted on August 6, 2008. In the interview, the applicants' representatives suggested claim amendments to clarify the structural relationship between the elements recited in the claims. Examiner Yabut stated that said proposed amendments appeared to overcome the rejections of the Office Action.

In the Office Action, claims 1, 6, 7 and 19 were rejected under 35 U.S.C. § 102(e) as being anticipate by U.S. Patent No. 5,437,266 to McPherson et al. ("McPherson"). According to the Office Action, McPherson discloses an elongate outer tube and a rotator cooperating within the actuator.

Claim 1, as presently amended, recites an applicator including, *inter alia*, an actuator, an outer tube, a rotator, and a fastener, wherein "actuation of the actuator rotates and translates the fastener relative to the outer tube while the rotator remains longitudinally stationary with respect to the outer tube."

Claim 19, as amended herein, recites an applicator including, an actuator, a rotator, an outer tube, and a fastener, "wherein actuation of the actuator rotates and translates the fastener relative to the outer tube and the rotator remains axially stationary with respect to the outer tube."

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McPherson relates to a surgical retractor configured to be inserted through a trocar. This surgical retractor includes a connector, a coil screw, and a shaft. The shaft includes a portion having a reduced diameter for receiving the coil screw. The coil screw can only be translated when the shaft, and thus the retractor, moves longitudinally. The coil screw cannot be translated while the shaft (or the entire retractor) remains longitudinally stationary with respect to the trocar.

In the Office Action, the retractor of McPherson was equated to the recited rotator, the trocar was equated to the recited outer tube, the coil screw was equated to the fastener, and the connector was equated to the actuator. Given the relationship between the coil screw and the shaft of the rotator, rotation of the retractor does not result in a rotation and translation of the coil screw relative to the trocar while the retractor remains longitudinally stationary with respect to the trocar, because the translation of the coil screw necessarily entails longitudinal movement of the retractor with respect to the trocar. Hence, McPherson fails to disclose or suggest an applicator including an actuator, an outer tube, a rotator, and a fastener, wherein actuation of the actuator rotates and translates the fastener relative to the outer tube while the rotator remains longitudinally stationary with respect to the outer tube, as substantially recited in claims 1 and 19. For at least the foregoing reasons, the applicants respectfully submit that claims 1 and 19 are patentable over McPherson and are in condition for allowance. Since claims 6 and 7 depend from claim 1, it is respectfully submitted that claims 6 and 7 are also in condition for allowance.

Claims 2 and 3 were rejected under 35 U.S.C. § 103(a) as being obvious over McPherson in view of U.S. Patent No. 4,596,350 to Smith et al. ("Smith"). According to the Office Action, McPherson discloses the applicators recited in claims 2 and 3 except for a lock/clip indicator and a load spring. The Office Action stated that Smith discloses a lock/clip indicator for engaging a

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plurality of fasteners from the applicator and a load spring for applying longitudinal forces against the lock/clip indicator and that it would be obvious to provide McPherson with the lock/clip indicator and load spring of Smith.

As previously discussed, McPherson does not disclose or suggest an applicator, including an actuator, an outer tube, a rotator, and a fastener, wherein actuation of the actuator rotates and translates the fastener relative to the outer tube while the rotator remains longitudinally stationary with respect to the outer tube, as substantially recited in claim 1. Adding the lock/clip indicator and load spring of Smith to McPherson fails to suggest the applicator recited in claim 1. Smith fails to disclose any additional features that, in combination with McPherson, suggest the applicator recited in claims 2 and 3. Since claims 2 and 3 depend from claim 1, it is respectfully submitted that these claims are in condition for allowance and the rejection of the Office Action has been overcome.

Claims 4 and 5 were rejected under 35 U.S.C. § 103(a) as being unpatentable over McPherson in view of U.S. Patent No. 5,433,721 to Hooven et al. ("Hooven"). The Office Action stated that McPherson discloses the applicators recited in claims 4 and 5 except for a thread form contained in an interior of the terminal end adapted to engage the plurality of fasteners and an interlock spring fixedly retained in the interior of the terminal end. Further, the Office Action asserted that Hooven discloses a thread form and an interlock spring and that it would be obvious to provide McPherson with the threaded form and interlock spring of Hooven.

As previously discussed, McPherson does not disclose or suggest an applicator including an actuator, an outer tube, a rotator, and a fastener, wherein actuation of the actuator rotates and translates the fastener relative to the outer tube while the rotator remains longitudinally stationary with respect to the outer tube, as substantially recited in claim 1. Adding the helical

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thread form of Hooven to McPherson fails to suggest the applicator recited in claim 1. Hooven fails to disclose or suggest any additional features that, in combination with McPherson, suggest the applicator recited in claims 4 and 5. Since claims 4 and 5 depend from claim 1, it is respectfully submitted that these claims are in condition for allowance and the rejection of the Office Action has been overcome.

Claim 8 was rejected under 35 U.S.C. § 103(a) as being unpatentable over McPherson in view of U.S. Patent No. 5,100,420 to Green et al. ("Green"). According to the Office Action, McPherson discloses the device recited in claim 8 except for a distal portion being disposable and the proximal portion being reusable. The Office Action asserted that Green discloses a distal portion being disposable and the proximal portion being reusable and that it would be obvious to provide McPherson with the disposable distal portion and the reusable proximal portion of Green.

As discussed above, McPherson does not disclose or suggest an applicator including an actuator, an outer tube, a rotator, and a fastener, wherein actuation of the actuator rotates and translates the fastener relative to the outer tube while the rotator remains longitudinally stationary with respect to the outer tube, as substantially recited in claim 1. Adding the distal and proximal portions of Green to McPherson fails to suggest the applicator recited in claim 1. Green fails to disclose or suggest any additional features that, in combination with McPherson, suggest the applicator recited in claim 8. Since claim 8 depends from claim 1, it is respectfully submitted that this claim is in condition for allowance and the rejection of the Office Action has been overcome.

Claims 9 and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over McPherson in view of U.S. Patent No. 5,607,436 to Pratt et al. ("Pratt"). The Office Action

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asserted that McPherson discloses the applicators recited in claims 9 and 14 except for a lever having a first end, a midsection, a second end, a lead screw, and a nut driver. The Office Action stated that Pratt discloses a lever having a first end, a midsection, a second end, a lead screw, and a nut driver and that it would be obvious to provide McPherson with the lever, midsection, second end, lead screw, and nut driver of Pratt.

As discussed hereinabove, McPherson does not disclose or suggest an applicator including an actuator, an outer tube, a rotator, and a fastener, wherein actuation of the actuator rotates and translates the fastener relative to the outer tube while the rotator remains longitudinally stationary with respect to the outer tube, as substantially recited in claim 1. Adding the lever of Pratt to McPherson fails to suggest the applicator recited in claim 1. Pratt fails to disclose or suggest any additional features that, in combination with McPherson, suggest the applicator recited in claims 9 and 14. Since claims 9 and 14 depend from claim 1, it is respectfully submitted that these claims are in condition for allowance and the rejection of the Office Action has been overcome.

Claim 11 was rejected under 35 U.S.C. § 103(a) as being unpatentable over McPherson in view of Pratt. The Office Action noted that McPherson discloses the applicator recited in claim 11 except for a lever having a midsection extension. The Office Action further stated that Pratt discloses a lever having a midsection extension and that it would be obvious to provide McPherson with the lever of Pratt.

As discussed above, McPherson does not disclose or suggest an applicator including an actuator, an outer tube, a rotator, and a fastener, wherein actuation of the actuator rotates and translates the fastener relative to the outer tube while the rotator remains longitudinally stationary with respect to the outer tube, as substantially recited in claim 1. Adding the lever of

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Pratt to McPherson fails to suggest the applicator recited in claim 1. Pratt fails to disclose or suggest any additional features that, in combination with McPherson, suggest the applicator recited in claim 11. Since claim 11 depends from claim 1, it is respectfully submitted that this claim is in condition for allowance and the rejection of the Office Action has been overcome.

Claims 12, 13, 16 and 18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over McPherson in view of Pratt. According to the Office Action, McPherson discloses the devices recited in claims 12, 13, 16, and 18 except for gear teeth, a spring loaded pawl, and a ratchet mechanism. The Office Action asserted that Pratt discloses gear teeth formed within the interior of a handle, a spring loaded pawl pivotally attached to the midsection extension and adapted to engage the gear teeth and a releasable engagement means that is a ratchet mechanism and that it would be obvious to provide McPherson with the gear teeth, the spring loaded pawl, and the releasable engagement means of Pratt.

As discussed hereinabove, McPherson does not disclose or suggest an applicator including an actuator, an outer tube, a rotator, and a fastener, wherein actuation of the actuator rotates and translates the fastener relative to the outer tube while the rotator remains longitudinally stationary with respect to the outer tube, as substantially recited in claim 1. Adding gear teeth, a spring loaded pawl, and a ratchet mechanism of Pratt to McPherson fails to suggest the applicator recited in claim 1. Pratt fails to disclose or suggest any additional features that, in combination with McPherson, suggest the applicator recited in claims 12, 13, 16, and 18. Since claims 12, 13, 16, and 18 depend from claim 1, it is respectfully submitted that these claims are in condition for allowance and the rejection of the Office Action has been overcome.

Claims 10 and 15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over McPherson. The Office Action asserted that McPherson discloses the devices recited in claims

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10 and 15 except for the lead screw being a high helix lead screw and that it would have been obvious to provide a high helix lead screw.

As discussed above, McPherson does not disclose or suggest an applicator including an actuator, an outer tube, a rotator, and a fastener, wherein actuation of the actuator rotates and translates the fastener relative to the outer tube while the rotator remains longitudinally stationary with respect to the outer tube, as substantially recited in claim 1. Adding a high helix lead screw to McPherson fails to suggest the applicator recited in claim 1. Since claims 10 and 15 depend from claim 1, it is respectfully submitted that these claims are in condition for allowance and the rejection of the Office action has been overcome.

Claims 17 and 18 were rejected under 35 U.S.C. § 103(a) as being obvious over McPherson in view of Pratt and U.S. Patent No. 5,487,500 to Knodel et al. ("Knodel"). The Office Action stated that McPherson and Pratt disclose the applicator recited in claims 17 and 18 except for a plurality of teeth formed on the mid-section extension. The Office Action asserted that Knodel discloses a mid-section extension formed with a plurality of teeth and that it would be obvious to provide McPherson and Pratt with the plurality of teeth of Knodel.

As previously discussed, McPherson does not disclose or suggest an applicator including an actuator, an outer tube, a rotator, and a fastener, wherein actuation of the actuator rotates and translates the fastener relative to the outer tube while the rotator remains longitudinally stationary with respect to the outer tube, as substantially recited in claim 1. Adding the mid-section extension of Knodel to McPherson and Pratt fails to suggest the applicator recited in claim 1. Knodel fails to disclose or suggest any additional features that, in combination with McPherson and Pratt, suggest the applicators recited in claims 17 and 18. Since claims 17 and 18 depend from claim 1, it is respectfully submitted that these claims are in condition for

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allowance and the rejection of the Office Action has been overcome.

In view of the foregoing, reconsideration of the application and allowance of claims 1-19 is earnestly solicited. Should the Examiner desire a telephonic interview to resolve any outstanding matters, the Examiner is sincerely invited to contact the undersigned at (631) 501-5710.

Please charge any deficiency as well as any other fee(s) which may become due under 37 C.F.R. § 1.16 and/or 1.17 at any time during the pendency of this application, or credit any overpayment of such fee(s) to Deposit Account No. 21-0550. Also, in the event any extensions of time for responding are required for the pending application(s), please treat this paper as a petition to extend the time as required and charge Deposit Account No. 21-0550 therefor

Respectfully submitted,



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